

## REMARKS/ARGUMENTS

Claims 50-113 are pending in the application. Claims 50-77, 92-97, and 102-113 are rejected under 35 U.S.C. 101; claims 50-113 are rejected under 35 U.S.C. 112; and claims 50-113 are rejected under 35 U.S.C. 103. The rejection is traversed and reconsideration is requested.

### *Claim Amendments*

Independent method claim 50 is amended to clarify:

- scanning via a first computer software process executing on an imaging station computer hardware device a front face and a back face of cash received for deposit at a first location and creating via the first computer software process executing on the imaging station computer hardware device an electronic validation of deposited cash (See, e.g., Specification, p. 5, line 29-p. 6, line 2 and Fig. 1)
- transmitting by a second computer software process executing on the imaging station computer hardware device the electronic validation of deposited cash from the first location via an imaging server to an image database at a second location (See, e.g., Specification, p. 6, lines 2-6 and Fig. 1)
- processing a transaction at the second location with the electronic validation of deposited cash via at least one of a computer software process executing on an edit and validation computer hardware terminal device, a computer software process executing on an encoder computer hardware device, a computer software process executing on an image printer computer hardware device, and a computer software process executing on a sorter/imager computer hardware device, each coupled to the image database (See, e.g., Specification, p. 6, lines 6-13 and Fig. 1)

Independent system claim 53 is amended to clarify:

- a first computer software process executing on an imaging station computer hardware device that scans a front face and a back face of cash accepted as a deposited item at a first location and creates an image of the deposited cash (See, e.g., Specification, p. 5, line 29-p. 6, line 2 and Fig. 1)
- a second computer software process executing on the imaging station computer hardware device that creates and transmits an electronic validation of deposited cash from the first location via an imaging server to an image database at a second location (See, e.g., Specification, p. 6, lines 2-6 and Fig. 1)
- at least one of a computer software process executing on an edit and validation computer hardware terminal device, a computer software process executing on an encoder computer hardware device, a computer software process executing on an image printer

computer hardware device, and a computer software process executing on a sorter/imager computer hardware device, each coupled to the image database, via which a transaction with the electronic validation of deposited cash is processed at the second location (See, e.g., Specification, p. 6, lines 6-13 and Fig. 1)

Claim 54 depending on claim 53 is amended to clarify:

- a display screen of the imaging station computer hardware device located at the first location that displays an image of the scanned cash and provides visual confirmation to a customer that the deposit has been accepted. (See, e.g., Specification, p. 6, lines 14-29 and Figs. 1 and 2)

Independent method claim 55 is amended to clarify:

- scanning via a first computer software process executing on an imaging station computer hardware device a front face and a back face of an original paper check received for deposit at a first location and creating via the first computer software process executing on the imaging station computer hardware device a deposited check (See, e.g., Specification, p. 5, line 29-p. 6, line 2 and Fig. 1)
- transmitting by a second computer software process executing on the imaging station computer hardware device an image of the scanned deposited check from the first location via an imaging server to an image database at a second location (See, e.g., Specification, p. 6, lines 2-6 and Fig. 1)
- processing a transaction at the second location with the scanned image of the deposited check via at least one of a computer software process executing on an edit and validation computer hardware terminal device, a computer software process executing on an encoder computer hardware device, a computer software process executing on an image printer computer hardware device, and a computer software process executing on a sorter/imager computer hardware device, each coupled to the image database, without pickup of the original paper check received at the first location (See, e.g., Specification, p. 6, lines 6-13 and Fig. 1)

Independent system claim 77 is amended to clarify:

- a first computer software process executing on a scanner computer hardware device located at a first location that scans a front face and a back face of an original paper check accepted as a deposited item at a first location and creates an image of a deposited check (See, e.g., Specification, p. 5, line 29-p. 6, line 2 and Fig. 1)
- a second computer software process executing on the scanner computer hardware device that transmits an image of the scanned deposited check from the first location via an imaging server to an image database at a second location (See, e.g., Specification, p. 6, lines 2-6 and Fig. 1)

- at least one of a computer software process executing on an edit and validation computer hardware terminal device, a computer software process executing on an encoder computer hardware device, a computer software process executing on an image printer computer hardware device, and a computer software process executing on a sorter/imager computer hardware device, each coupled to the image database, via which a transaction with the image of the scanned deposited check is processed at the second location without pickup of the original paper check received at the first location (See, e.g., Specification, p. 6, lines 6-13 and Fig. 1)

Claims 78 and 79 depending on claim 77 are amended to address editorial issues raised by the amendment of claim 77.

Claim 85 depending on claim 77 is amended to clarify:

- an input device of the scanner computer hardware device via which entry of an amount on the check which has been scanned is separately received; and a third computer software process executing on the scanner computer hardware device that compares the amount entered with an amount scanned and allows transmission to conduct processing of the transaction. (See, e.g., Specification, p. 6, line 26-p. 7, line 4 and Figs. 1 and 2)

Claim 86 depending on claim 77 is amended to clarify:

- a fourth computer software process executing on the scanner computer hardware device that compresses, encrypts and digitally signs the scanned check before transmission to the second location for processing. (See, e.g., Specification, p. 7, lines 5-11 and Figs. 1 and 2)

Claim 87 depending on claim 77 is amended to clarify:

- one of the computer software process executing on the encoder computer hardware device at the second location and the computer software process executing on the image database at the second location that sends the image of the scanned deposited check received by the image database to a third location for processing within or for another bank. (See, e.g., Specification, p. 7, line 24-p. 8, line 5 and Figs. 1 and 2)

Claim 88 depending on claim 77 is amended to clarify:

- the computer software process executing on the image database at the second location that sends the image of the scanned deposited check received by the image database to the a Federal Reserve Bank or one of its offices or a clearinghouse as a third location, and the third location has means for creating the images on paper and Magnetic Image Character Recognition MICR encodes them for entry into the check processing system or

sending the information to a bank for payment. (See, e.g., Specification, p. 7, line 24-p. 8, line 5 and Figs. 1 and 2)

Claim 89 depending on claim 77 is amended to clarify:

- the computer software process executing on the image database at the second location that sends the image of the scanned deposited check received by the image database directly to a payor bank or its processing agent or correspondent for payment. (See, e.g., Specification, p. 7, line 24-p. 8, line 5 and Figs. 1 and 2)

Claims 90 and 91 depending on claim 77 are likewise amended to address editorial issues raised by the amendment of claim 77.

Independent method claim 92 is amended to clarify:

- scanning via a first computer software process executing on an imaging station computer hardware device a front face and a back face of an original paper check received for deposit at a first location and creating via the first computer software process executing on the imaging station computer hardware device a deposited check (See, e.g., Specification, p. 5, line 29-p. 6, line 2 and Fig. 1)
- transmitting by a second computer software process executing on the imaging station computer hardware device an image of the scanned deposited check from the first location via an imaging server to an image database at a second location (See, e.g., Specification, p. 6, lines 2-6 and Fig. 1)
- processing a transaction at the second location with the scanned image of the deposited check via at least one of a computer software process executing on an edit and validation computer hardware terminal device, a computer software process executing on an encoder computer hardware device, a computer software process executing on an image printer computer hardware device, and a computer software process executing on a sorter/imager computer hardware device, each coupled to the image database, without verification of a signature of a user initiating the transaction, which signature is used to verify that the user is a profiled user with a specified system, and without pickup of the original paper check received at the first location (See, e.g., Specification, p. 6, lines 6-13 and Fig. 1)

Independent system claim 97 is amended to clarify:

- a first computer software process executing on a scanner computer hardware device located at a first location that scans a front face and a back face of an original paper check accepted as a deposited item at a first location and creates an image of a deposited instrument (See, e.g., Specification, p. 5, line 29-p. 6, line 2 and Fig. 1)

- a second computer software process executing on the scanner computer hardware device that transmits an image of the scanned deposited check from the first location via an imaging server to an image database at a second location (See, e.g., Specification, p. 6, lines 2-6 and Fig. 1)
- at least one of a computer software process executing on an edit and validation computer hardware terminal device, a computer software process executing on an encoder computer hardware device, a computer software process executing on an image printer computer hardware device, and a computer software process executing on a sorter/imager computer hardware device, each coupled to the image database, via which a transaction with the image of the scanned deposited check is processed at the second location without verification of a signature of a user initiating the transaction, which signature is used to verify that the user is a profiled user within a specified system, and without pickup of the original paper check received at the first location (See, e.g., Specification, p. 6, lines 6-13 and Fig. 1)

Independent method claim 102 is amended to clarify:

- receiving for deposit via a first computer software process executing on a self-service transaction terminal computer hardware device at a first location a check having a front face and a back face, wherein the check is an original paper check (See, e.g., Specification, p. 5, line 29-p. 6, line 2 and Fig. 1)
- scanning via a second computer software process executing on the self-service transaction terminal computer hardware device the front face and the back face of the paper check and creating via the second computer software process executing on the self-service transaction terminal computer hardware device a deposited check (See, e.g., Specification, p. 5, line 29-p. 6, line 2 and Fig. 1)
- marking via a third computer software process executing on the self-service transaction terminal computer hardware device the paper check with an indicia of non-negotiability and storing by the third computer software process executing on the self-service transaction terminal computer hardware device the marked paper check in a depository at the first location (See, e.g., Specification, p. 8, lines 22-27 and Figs. 8 and 9)
- transmitting by a fourth computer software process executing on the self-service transaction terminal computer hardware device an image of the scanned deposited check from the first location via an imaging server to an image database at a second location (See, e.g., Specification, p. 6, lines 2-6 and Fig. 1)
- processing a transaction at the second location with the scanned image of the deposited check via a computer software process executing on an edit and validation computer hardware terminal device coupled to the image database (See, e.g., Specification, p. 6, lines 6-13 and Fig. 1)

Claim 103 depending on claim 102 is amended to clarify:

- storing the paper check by the third computer software process executing on the self-service transaction terminal computer hardware device for a pre-determined delay period before pickup of the original paper check. (See, e.g., Specification, p. 8, lines 22-27 and Figs. 8 and 9)

Claim 104 depending on claim 102 is amended to clarify:

- storing the paper check by the third computer software process executing on the self-service transaction terminal computer hardware device without pickup of the original paper check. (See, e.g., Specification, p. 8, lines 22-27 and Figs. 8 and 9)

Independent method claim 105 is amended to clarify:

- a first computer software process executing on a self-service transaction terminal computer hardware device via which a check having a front face and a back face is accepted as a deposited item at a first location, wherein the check is an original paper check (See, e.g., Specification, p. 5, line 29-p. 6, line 2 and Fig. 1)
- a second computer software process executing on a scanner computer hardware device coupled to the self-service transaction terminal computer hardware device located at a the first location that scans the front face and the back face of the check and creates an image of a deposited check (See, e.g., Specification, p. 5, line 29-p. 6, line 2 and Fig. 1)
- a third computer software process executing on the self-service transaction terminal computer hardware device via which the original paper check is marked with an indicia of non-negotiability and stored in a depository at the first location (See, e.g., Specification, p. 8, lines 22-27 and Figs. 8 and 9)
- a fourth computer software process executing on the self-service transaction terminal computer hardware device that transmits an image of the scanned deposited check from the first location via an imaging server to an image database at a second location (See, e.g., Specification, p. 6, lines 2-6 and Fig. 1)
- a computer software process executing on an encoder computer hardware device coupled to the image database, via which a transaction with the image of the scanned deposited check is processed at the second location (See, e.g., Specification, p. 6, lines 6-13 and Fig. 1)

Claim 106 depending on claim 105 is amended to clarify:

- the third computer software process executing on the self-service transaction terminal computer hardware device that stores the original paper check for a pre-determined delay period before pickup of the original paper check. (See, e.g., Specification, p. 8, lines 22-27 and Fig. 1)

Claim 107 depending on claim 105 is amended to clarify:

- the third computer software process executing on the self-service transaction terminal computer hardware device that stores the original paper check without pickup of the original paper check. (See, e.g., Specification, p. 8, lines 22-27 and Figs. 8 and 9)

Independent method claim 108 is amended to clarify:

- receiving for deposit via a first computer software process executing on a self-service transaction terminal computer hardware device at a first location a check having a front face and a back face, wherein the check is an original paper check (See, e.g., Specification, p. 5, line 29-p. 6, line 2 and Fig. 1)
- scanning via a second computer software process executing on the self-service transaction terminal computer hardware device the front face and the back face of the original paper check and creating via the second computer software process executing on the self-service transaction terminal computer hardware device a deposited check (See, e.g., Specification, p. 5, line 29-p. 6, line 2 and Fig. 1)
- marking via a third computer software process executing on the self-service transaction terminal computer hardware device the original paper check with an indicia of non-negotiability and storing by the third computer software process executing on the self-service transaction terminal computer hardware device the marked original paper check in a depository at the first location (See, e.g., Specification, p. 8, lines 22-27 and Figs. 8 and 9)
- transmitting by a fourth computer software process executing on the self-service transaction terminal computer hardware device an image of the scanned deposited check from the first location via an imaging server to an image database at a second location (See, e.g., Specification, p. 6, lines 2-6 and Fig. 1)
- processing via a computer software process executing on an image printer computer hardware device coupled via a check imaging server to the image database a transaction at the second location with the scanned image of the deposited check without verification of a signature of a user initiating the transaction, which signature is used to verify that the user is a profiled user with a specified system (See, e.g., Specification, p. 6, lines 6-13 and Fig. 1)

Claim 109 depending on claim 108 is amended to clarify:

- storing the paper check by the third computer software process executing on the self-service transaction terminal computer hardware device for a pre-determined delay period before pickup of the original paper check (See, e.g., Specification, p. 8, lines 22-27 and Figs. 8 and 9)

Claim 109 depending on claim 108 is amended to clarify:

- storing the original paper check by the third computer software process executing on the self-service transaction terminal computer hardware device without pickup of the original paper check (See, e.g., Specification, p. 8, lines 22-27 and Figs. 8 and 9)

Independent system claim 111 is amended to clarify:

- a first computer software process executing on a self-service transaction terminal computer hardware device via which a check having a front face and a back face is accepted as a deposited item at a first location, wherein the check is an original paper check (See, e.g., Specification, p. 5, line 29-p. 6, line 2 and Fig. 1)
- a second computer software process executing on a scanner computer hardware device coupled to the self-service transaction terminal computer hardware device located at a the first location that scans the front face and the back face of the check and creates an image of a deposited check (See, e.g., Specification, p. 5, line 29-p. 6, line 2 and Fig. 1)
- a third computer software process executing on the self-service transaction terminal computer hardware device via which the original paper check is marked with an indicia of non-negotiability and stored in a depository at the first location (See, e.g., Specification, p. 8, lines 22-27 and Fig. Figs. 8 and 9)
- a fourth computer software process executing on the self-service transaction terminal computer hardware device that transmits an image of the scanned deposited check from the first location via an imaging server to an image database at a second location (See, e.g., Specification, p. 6, lines 2-6 and Fig. 1)
- a computer software process executing on a sorter/imager computer hardware device coupled to the image database via which a transaction with the image of the scanned deposited check is processed at the second location without verification of a signature of a user initiating the transaction, which signature is used to verify that the user is a profiled user within a specified system (See, e.g., Specification, p. 6, lines 6-13 and Fig. 1)

Claim 112 depending on claim 111 is amended to clarify:

- the third computer software process executing on the self-service transaction terminal computer hardware device that stores the original paper check for a pre-determined delay period before pickup of the original paper check. (See, e.g., Specification, p. 8, lines 22-27 and Figs. 8 and 9)

Claim 112 depending on claim 111 is amended to clarify:

- the third computer software process executing on the self-service transaction terminal computer hardware device that stores the paper check without pickup of the original paper check. (See, e.g., Specification, p. 8, lines 22-27 and Figs. 8 and 9)



Support for the amendment is found throughout the specification as noted above and in the claims. Further, under U.S. patent practice, as provided in the MPEP, “[t]he subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement.” (See MPEP § 2163.02). Hence, “the specification conveys with reasonable clarity to those skilled in the art” that Applicant was in possession of the invention as claimed. (See MPEP § 2163.02 (citing *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991)).

### ***Claim Rejections - 35 USC § 101***

Claims 55, 77, 92 and 97 stand rejected under 35 USC §101 because the examiner believes that the inclusion of a “whereby” clause renders the claims non-statutory. While that premise is believed to be incorrect, nevertheless the foregoing amendment deleting all occurrences of “whereby” from the claims renders the rejection moot.

Claims 50-76, 92-96 and 102-113 likewise stand rejected under 35 U.S.C. §101 as non-statutory by the examiner, invoking *In re Bilski* by inference. The amendment of independent method claims 50, 55, 92, 102, and 108 to recite the particular computer software process executing on the particular computer hardware device for each step employed in the method of claims 50, 55, 92, 102, and 108 renders moot the rejection under 35 U.S.C. 101 of independent method claims 50, 55, 92, 102, and 108, and claims 51 and 52 depending on claim 50, claims 56-76 depending on claim 55, claims 93-96 depending on claim 92, claims 103 and 104 depending on claim 102, and claims 109 and 110 depending on claim 108.

Likewise, the amendment of independent system claims 105 and 111 to recite the particular computer software process executing on the particular computer hardware device that accepts, scans, marks, transmits, and processes in the system of claims 105 and 111 renders moot the rejection under 35 U.S.C. 101 of independent system claims 105 and 111, and claims 106 and 107 depending on claim 105 and claims 112 and 113 depending on claim 111.

Amended independent method claims 50, 55, 92, 102, and 108, and claims 51 and 52 depending on claim 50, claims 56-76 depending on claim 55, claims 93-96 depending on claim 92, claims 103 and 104 depending on claim 102 and amended independent system claims 105

and 111, and claims 106 and 107 depending on claim 105 and claims 112 and 113 depending on claim 111 clearly recite methods and systems, respectively, that claim statutory subject matter under 35 U.S.C. 101. See, e.g., *Ex Parte Wasynczuk*, No. 2008-1496 (2 June 2008).

### ***Claim Rejections - 35 USC § 112***

Claims 50-76, 92-96 and 102-112 also stand rejected under 35 U.S.C. 112, first paragraph, because the examiner considers that the claims contain subject matter which he cannot find described in the specification, namely, “what structure is being used to perform receiving, scanning, transmitting and processing”; claims 50-76, 92-96, and 102-113 stand rejected under 35 U.S.C. 112, second paragraph, because the examiner considers them to be “indefinite” without further explanation; and claims 50-96, 102-104, and 108-110 stand rejected under 35 U.S.C. 112, second paragraph, as omitting “a scanner, device used for receiving, device used for transmitting, processing etc.”.

Regarding the rejection of claims 50-76, 92-96 and 102-112 under 35 U.S.C. 112, first paragraph, with respect, the examiner’s inability to find support for the claimed subject matter in the specification is puzzling as the specification is replete with detailed descriptions of the particular computer software processes executing on the particular computer hardware devices that receive, scan, transmit and process, etc. in the claimed methods and systems for embodiments of the invention. For only one of numerous examples, at p. 5, line 29-p. 6, line 25, the specification explains:

Fig. 1 generally shows a deposit location 13 connected through a network 15, or directly, to a database 25 and to a check processing location 17. The deposit location 13 includes a check imaging station which can be an ATM or teller station 19 which is used to scan in the check, and to capture the MICR code line data via magnetic or optical character recognition (OCR) hardware and software technology, and either transmit it through a connection 23 to the network, which then in turn connects to a check imaging server 27 providing short term storage at the check process location 17, or transmits to an optional local server 21 connected to a negative (fraud and loss detection) database 25, which transmits the check image to the check imaging server 27. The check image can then be transmitted to a check image database 31 connected to the server 27 for manipulation at a terminal 33. At the terminal 33 check editing and validation can be conducted. Similarly, a check encoder 39 can serve to encode the check or alternatively the check can be encoded automatically based upon the scanned image, and generate a paper check copy for transmission to a making bank 41. A check printer 35 is connected to the server 27 from where check images can be printed and transmitted to the making bank 41.

Similarly, a check sorter/imager 37 can be connected to the image database 31 for providing appropriate sorting functionality.

Certain aspects of the system of Fig. 1 are further illustrated in greater detail in Figure 2. For instance, an alternative to an ATM can be a customer access terminal (CAT) 101 which can be the deposit location 13 at the remote banking center. The CAT 101 will have a scanner or check imager in place of a traditional envelope deposit slot as currently used in automatic teller machines. In addition, the CAT will also include a cash acceptor/validator as well as a cash dispenser to provide functionality similar to automatic teller machines currently in use. Thus, in accordance with its use, the CAT 101 is configured to accept check or cash deposit items with no envelope. Two separate cash and check entry points may be used, but alternatively, a single entry point check scanner/validator can be used as may be readily apparent to those of ordinary skill in the art. Such a device would combine conventional image scanning, magnetic and optical character recognition, and bank note validation hardware and software into a single device.

The CAT can be programmed to validate check items through MICR code line and OCR software. When a check is scanned in, an image of each check is presented on the customer display. The customer can then, using an appropriate keyboard, input the check amount. The CAT can then determine the check amount through a combination of Courtesy Account Recognition (CAR) software and Legal Amount Recognition (LAR) software, for improved confidence. A comparison between the scanned amount and the entered amount is made, and if there is a match, the transaction proceeds. If the customer's input and the courtesy amount recognition differ, even after a customer's second input, the system will send the check image to a customer service operator who will be able to read the check and resolve any discrepancies.

Regarding the rejection of claims 50-76, 92-96, and 102-113 under 35 U.S.C. 112, second paragraph, as "indefinite" and the rejection of claims 50-96, 102-104, and 108-110 under 35 U.S.C. 112, second paragraph, as omitting "a scanner, device used for receiving, device used for transmitting, processing etc.", the amendment of independent method claims 50, 53, 55, 77, 92, 102, 105, and 108 to recite the particular computer software process executing on the particular computer hardware device for each step employed in the method of claims 50, 55, 92, 102, and 108 renders moot the rejection under 35 U.S.C. 112, second paragraph, of independent method claims 50, 55, 92, 102, and 108, and claims 51 and 52 depending on claim 50, claims 56-76 depending on claim 55, claims 93-96 depending on claim 92, claims 103 and 104 depending on claim 102, and claims 109 and 110 depending on claim 108.

Likewise, the amendment of independent system claims 53, 77, 105, and 111 to recite the particular computer software process executing on the particular computer hardware device that

accepts, scans, marks, transmits, and processes in the system of claims 53, 77, 105, and 111 renders moot the rejection under 35 U.S.C. 112, second paragraph, of independent system claims 53, 77, 105, and 111, and claim 54 depending on claim 53, claims 78-91 depending on claim 77, claims 106 and 107 depending on claim 105 and claims 112 and 113 depending on claim 111.

### ***Claim Rejections - 35 USC § 103***

Claims 50-113 stand rejected under 35 U.S.C. Section 103(a) as obvious over Gustin (US 5,829,625) in view of Wensink (US 5,431,389). The rejection is traversed and reconsideration is requested.

The proposed modification of Gustin in view of Wensink lacks one or more limitations recited in each of amended independent claims 50, 53, 55, 77, 92, 97, 102, 105, 108, and 111 and there is inadequate articulated reasoning with rational underpinning to support the Examiner's legal conclusion of obviousness in at least the following respects:

- It is true that Gustin discloses an ATM that receives deposits of cash or checks (Gustin, Fig. 13), photographs checks and money orders and reads magnetic ink (Gustin, Abstract, Col 18, lines 3-7) and wires deposit or payment instructions to corresponding banks, merchants, etc. (Gustin, Col. 4, lines 3-8 and lines 42-56) and that Wensink discloses a hand document scanner (Wensink, Col. 6, lines 50-64). However, Gustin and/or Wensink, separately or in combination with one another, fail to teach or suggest:
  - transmitting by a second computer software process executing on the imaging station computer hardware device an image of the scanned deposited check from the first location via an imaging server to an image database at a second location, as recited in amended independent claim 55, and similarly in each of amended independent claims 77, 92, 97, 102, 105, 108, and 111. On the contrary, instead of transmitting an image of a deposited check, Gustin discloses simply wiring deposit or payment instructions to corresponding banks, merchants, etc. (Gustin, Col. 4, lines 3-8 and lines 42-56), and Wensink merely discloses a hand document scanner (Wensink, Abstract).

- processing a transaction at the second location ... via at least one of a computer software process executing on an edit and validation computer hardware terminal device, a computer software process executing on an encoder computer hardware device, a computer software process executing on an image printer computer hardware device, and a computer software process executing on a sorter/imager computer hardware device, each coupled to the image database, as recited in amended independent claim 50 and similarly in each of amended independent claims 53, 55, 77, 92, and 93. Instead of processing at the second location via software executing on one or more of an edit and validation terminal, an encoder device, an image printer device, or a sorter/imager device, each coupled to an image database, Gustin simply discloses connecting the ATM over a network to a bank (Gustin, Col 10, lines 56-58, Col 19, lines 55-58) and Wensink discloses a hand scanner and paper guide (Wensink, Abstract).
- processing a transaction at the second location with the scanned image of the deposited check .... without pickup of the original paper check received at the first location, as recited in amended independent claim 92, and similarly in amended independent claim 97. On the contrary, instead of processing at the second location with a scanned image of a deposited check without pickup of the original check received at the first location, Gustin simply discloses connecting the ATM over a network to a bank and wiring deposit or payment instructions to corresponding banks, merchants, etc. (Gustin, Col. 4, lines 3-8 and lines 42-56, Col 10, lines 56-58; and Col 19, lines 55-58) and Wensink discloses a hand scanner (Wensink, Abstract).
- processing a transaction at the second location with the scanned image of the deposited check via a computer software process executing on an edit and validation computer hardware terminal device coupled to the image database, as recited in amended independent claim 102. Instead of processing a transaction at the second location with the scanned image of the deposited check via a computer software process executing on an edit and validation computer hardware terminal device coupled to the image database, as noted above, Gustin simply discloses

connecting the ATM over a network to a bank (Gustin, Col 10, lines 56-58, Col 19, lines 55-58) and Wensink discloses a hand scanner and paper guide (Wensink, Abstract).

- a computer software process executing on an encoder computer hardware device coupled to the image database, via which a transaction with the image of the scanned deposited check is processed at the second location, as recited in amended independent claim 105. Instead of a computer software process executing on an encoder computer hardware device coupled to the image database, via which a transaction with the image of the scanned deposited check is processed at the second location, as already noted Gustin simply discloses connecting the ATM over a network to a bank (Gustin, Col 10, lines 56-58, Col 19, lines 55-58) and Wensink discloses a hand scanner (Wensink, Abstract).
- processing via a computer software process executing on an image printer computer hardware device coupled via a check imaging server to the image database a transaction at the second location with the scanned image of the deposited check, as recited in amended independent claim 108. On the contrary, instead of processing via a computer software process executing on an image printer computer hardware device coupled via a check imaging server to the image database a transaction at the second location with the scanned image of the deposited check, Gustin simply discloses connecting the ATM over a network to a bank (Gustin, Col 10, lines 56-58, Col 19, lines 55-58) and Wensink discloses a hand scanner and paper guide (Wensink, Abstract).
- a computer software process executing on a sorter/imager computer hardware device coupled to the image database via which a transaction with the image of the scanned deposited check is processed at the second location, as recited in amended independent claim 111. Instead of a computer software process executing on a sorter/imager computer hardware device coupled to the image database via which a transaction with the image of the scanned deposited check is processed at the second location, as previously noted, Gustin simply discloses connecting the ATM over a network to a bank (Gustin, Col 10, lines 56-58, Col

19, lines 55-58) and Wensink discloses a hand scanner and paper guide (Wensink, Abstract).

- marking via a third computer software process executing on the self-service transaction terminal computer hardware device the paper check with an indicia of non-negotiability and storing by the third computer software process executing on the self-service transaction terminal computer hardware device the marked paper check in a depository at the first location, as recited in amended independent claim 102 and similarly in each of amended independent claims 105, 108, and 111. On the contrary, instead of marking the paper check with an indicia of non-negotiability and storing the marked paper check in a depository at the first location, Gustin discloses an ATM for receiving deposits of cash or checks (Gustin, Fig. 13) and wiring deposit or payment instructions to corresponding banks, merchants, etc. (Gustin, Col. 4, lines 3-8 and lines 42-56) and Wensink discloses nothing more than scanning documents with a hand scanner (Wensink, Col. 6, lines 50-64).

The Examiner's reasoning in rejecting amended independent claims 50, 53, 55, 77, 92, 97, 102, 105, 108, and 111 would have to be that having first thought of an ATM that photographs checks and money orders and reads magnetic ink and wires deposit or payment instructions to corresponding banks or merchants, as disclosed by Gustin, and a hand document scanner, as disclosed by Wensink, one of ordinary skill would have seen the advantages in developing a method and system that involves, for example:

- transmitting an image of the scanned deposited check from the first location to a second location, as recited in amended independent claim 55, and similarly in each of amended independent claims 77, 92, 97, 102, 105, 108, and 111; or
- processing at the second location via software executing on one or more of an edit and validation terminal, an encoder device, an image printer device, or a sorter/imager device as recited in amended independent claim 50 and similarly in each of amended independent claims, 53, 55, 77, 92, and 93; or

- processing a transaction at the second location with the scanned image of the deposited check without pickup of the original paper check received at the first location, as recited in amended independent claim 92, and similarly in amended independent claim 97; or
- processing a transaction at the second location with the scanned image of the deposited check via a computer software process executing on an edit and validation computer hardware terminal device coupled to the image database, as recited in amended independent claim 102; or
- a computer software process executing on an encoder computer hardware device coupled to the image database, via which a transaction with the image of the scanned deposited check is processed at the second location; as recited in amended independent claim 105, or
- processing via a computer software process executing on an image printer computer hardware device coupled via a check imaging server to the image database a transaction at the second location with the scanned image of the deposited check, as recited in amended independent claim 108; or
- a computer software process executing on a sorter/imager computer hardware device coupled to the image database via which a transaction with the image of the scanned deposited check is processed at the second location, as recited in amended independent claim 111; or
- marking a paper check with an indicia of non-negotiability and storing the marked paper check in a depository at the first location, as recited in amended independent claim 102 and similarly in each of amended independent claims 105, 108, and 111.

But the Examiner has not shown, and will be unable to show, how this follows, and more critically has failed to show, and will be unable to show, that one of ordinary skill would have considered developing such a system to begin with.

Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine



the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit. See In re Kahn, 441 F.3d 977, 988 (C.A.Fed.2006) ("[R]jections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness"). As our precedents make clear, however, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ. KSR Int'l v. Teleflex Inc., 127 S.Ct. 1727 at 1740-41 (2007).

The Examiner's reasoning that the development of such a system would be obvious "to modify Gustin to provide scanning of paper cash so as to provide a means for monitoring and tracking legal tender (paper cash or money)" is conclusory in that it begins with the claim limitation and from that infers a generic benefit in hindsight. This is not a rational underpinning that shows a connection by articulated reasoning of what those of ordinary skill knew, leading to the claim limitations at issue.

Consequently, Gustin and/or Wensink, separately or in combination with one another, do not recite the required combination of limitations of amended independent claims 50, 53, 55, 77, 92, 97, 102, 105, 108, and/or 111. Because the cited references, either alone or in combination, do not teach the limitations of amended independent claims 50, 53, 55, 77, 92, 97, 102, 105, 108, and/or 111, the Examiner has failed to establish the required *prima facie* case of unpatentability. In re Royka, 490 F.2d 981, 985 (C.C.P.A., 1974) (holding that a *prima facie* case of obviousness requires the references to teach all of the limitations of the rejected claim); See also MPEP 52143.03.

The Examiner has failed to establish the required *prima facie* case of unpatentability for amended independent claims 50, 53, 55, 77, 92, 97, 102, 105, 108, and 111, and similarly has failed to establish a *prima case* of unpatentability for claims 51 and 52 that depend on claim 50, claim 54 that depends on claim 53, claims 56-76 that depend on claim 55, claims 78-91 that depend on claim 77, claims 93-96 that depend on claim 92, claims 98-101 that depend on claim 97, claims 103 and 104 that depend on claim 102, claims 106 and 107 that depend on claim 105, claims 109 and 110 that depend on claim 108, and claims 112 and 113 that depend on claim 111,

and which recite further specific elements that have no reasonable correspondence with the references.

### Conclusion

In view of the foregoing amendment and these remarks, each of the claims remaining in the application is in condition for immediate allowance. Accordingly, the Examiner is requested to reconsider and withdraw the rejection and to pass the application to issue. The Examiner is respectfully invited to telephone the undersigned at 704-503-2579 to discuss any questions relating to the application.

Respectfully submitted,

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